

**REMARKS**

The Amendment, filed in response to the Office Action mailed August 8, 2009, is believed to fully address all and every issue raised in the Office Action. Favorable reconsideration on the merits and allowance of the application are respectfully requested.

***Disposition of Claims and Summary of Amendments***

Claims 1-7 and 10-22 are all the claims pending in the application. Claims 1-7, 10-12 and 15-19 are withdrawn from consideration as being directed to non-elected invention. Claims 13, 14, and 20-22 are considered.

In the instant Amendment, claims 8 and 9 are canceled. Claim 22 is amended to remove improper dependency (as a consequence of cancellation of claim 9). Claim 13 is amended to remove the parenthesis from the definition of functional groups. Claim 20 is amended to correct typographical errors.

No new matter is introduced and entry and consideration of the amendments are respectfully requested.

***Formal Matters***

Applicants thank the Examiner for considering and acknowledging the IDS submitted July 25, 2006.

Applicants note that the box 3. under (a) "All" of No. 12 "Priority Under 35 U.S.C. § 119" on Summary of Office Action is not checked. While it is Applicants' understanding that the Office intends to acknowledge receipt of the copies of the certified copies of the priority document have been received from the IB, Applicant respectfully request the box 3 be checked in the next Action.

***Response to the Rejections under 35 U.S.C. § 102***

In the Office Action, claims 8, 9, 13, 14, and 20-22 are rejected under 35 U.S.C. §102(b) as being anticipated by Inanaga et al. (EP 1134209 A1).

According to the Office Action, Inanaga teaches optically active binaphthol derivatives of formula 3 and 4 (page 6), allegedly meeting the limitations of claims 8, 9, 13, 14, 20 and 21. Also, the Office asserts that Inanaga teaches the compounds are useful as a catalyst for asymmetric synthesis, thus meeting the limitations of claim 22.

Applicants respectfully traverse for the following reasons.

Without acquiescing the rejection, in order to solely advance the prosecution, claims 8 and 9 are canceled, rendering the rejection of claims 8 and 9 moot.

With respect to claims 13, 14, and 20-22, Applicants respectfully submit that the optically active binaphthol derivative of formulas 3 and 4 are different from the phosphoric acid derivative of claims 13, 14 and 20-22. Inanaga fails to teach the compound of formula (11) or formula (31), in which wherein  $R^{31}$  to  $R^{40}$  *each independently* represent a substituent other than an alkyl-substituted phenyl group; provided that at least one of  $R^{31}$  to  $R^{35}$  and at least one of  $R^{36}$  to  $R^{40}$  are an aryl group optionally having substituent(s) (provided that an alkyl-substituted phenyl group is excluded); and  $Ar^1$  to  $Ar^5$  *each independently* represent a hydrogen atom or an alkyl-substituted phenyl group; provided that the case where all of  $Ar^1$  to  $Ar^5$  are a hydrogen atom is excluded.

Therefore, the rejection under 35 U.S.C. § 102 is not sustainable and its withdrawal is respectfully requested.

Applicants further argue that Inanaga also fails to provide any guidance or motivation to modify the compounds of formulas 3 and 4 to reach the compounds defined in claims 13, 14, and 20-22 of the instant application, with reasonable expectation of success.

***Conclusion***

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number **202-775-7588**.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

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